

#### REMARKS

Reconsideration of the application as amended is requested.

In the Office Action dated January 11, 2007, claims 1-13 were rejected under 35 U.S.C. §112, second paragraph. Claim 1 has been amended to correct the antecedent basis matter noted by the Examiner, such that claims 1-13 are now believed to comply with 35 U.S.C. §112, second paragraph. This amendment to claim 1 does not affect the scope of claim 1 in any way.

In the Office Action dated January 11, 2007, claims 1, 8, 9, 11, 12, 21, 26 and 28 were rejected under 35 U.S.C. §102(c) as being anticipated by Tsai U.S. Patent No. 6,948,775. Claims 2-7 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tsai '775. Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over Tsai '775, in view of Cao U.S. Patent No. 6,017,091. Claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over Tsai '775, in view of Wu U.S. Patent No. 5,931,536. Claims 22-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tsai '775, in view of Bivens U.S. Patent No. 5,498,039. Claim 27 was rejected under 35 U.S.C. §103(a) as being unpatentable over Tsai '775, in view of Cao '091. Claim 29 was rejected under 35 U.S.C. §103(a) as being unpatentable over Tsai '775, in view of Wu '536. Claims 31, 33 and 34 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tsai '775 in view of Bivens '039. Claim 32 was rejected under 35 U.S.C. §103(a) as being unpatentable over Tsai '775, in view of Cao '091. Claim 35 was rejected under 35 U.S.C. §103(a) as being unpatentable over Tsai '775, in view of Wu '536.

MPEP 2131 states that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 1 of the present application recites an armrest base member and a support member slidably coupled to the armrest base member for movement in first and second directions between first and second positions relative to the armrest base member, "wherein the support member is biased into the first position" (emphasis added). Applicants respectfully

assert that Tsai '775 does not disclose or suggest a support member that is biased into a first position as recited in claim 1. At column 4, lines 9-25, Tsai '775 states that,

When the office chair armrest of the present invention is to be adjusted forwards or backwards, referring to FIG. 5, it is only necessary to force the office chair armrest to move forward or backward with the base 3 and the upper cover 6 moved together, by which the engagement blocks 47 that are protruded at both sides of the locating seat 4 and engage in ones of the two pluralities of engagement grooves 32 of the guide rails 31 of the base 3 are forced to be shrunk into the depressions 44 of the locating seat 4 by the pressing of the guide rails 31 of the base 3 to make the springs 45 that are also disposed in the depressions 44 to be in a compressed status until the engagement blocks 47 are respectively forced to slide into and urged to engage in any required ones of the two pluralities of engagement grooves 32 firmly in position under the resilience of the springs 45, thus the adjustment of the office chair armrest in the present invention to move forward or backward can be achieved easily.

Thus, Tsai '775 teaches an armrest that can be shifted fore and aft and retained at a selected discreet position due to engagement of blocks 47 in engagement grooves 32. However, the armrest of Tsai '775 is not in any way biased into either the fore or aft position, such that Tsai '775 cannot anticipate claim 1.

Furthermore, Applicants further assert that there would be no reason to modify Tsai '775 to include a bias as recited in claim 1. Specifically, if a bias sufficient to overcome the retention force of the engagement blocks 47 of Tsai '775 were added, it would render the engagement blocks 47 and engagement grooves 32 unsuited for their intended purpose; namely retaining the base 3 and upper cover 6 at a selected fore/aft position. Applicants note that "If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP 2143.01, *citing In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (emphasis added). Conversely, the references themselves do not teach or suggest that there would be any motivation or advantage in providing a bias that is insufficient to overcome the retention force of the engagement blocks 47 and engagement grooves 32 of Tsai '775. According to MPEP 2143, one of the basic criteria that is required to establish a prima

facie case of obviousness is that "the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and that reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure." MPEP 2143; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 2-20 depend from claim 1, and are therefore believed to be allowable for those reasons set forth above in connection with claim 1.

Independent claim 21 recites a seating unit including a frame and a pair of armrests that are movably mounted to the frame for movement between forward and rearward positions. Claim 21 recites that "the armrests are biased into the forward position" (emphasis added).

As discussed above in connection with claim 1, Tsai '775 does not teach an armrest that is biased into a first or forward position. Accordingly, Tsai '775 cannot anticipate claim 21, and the rejection under §102(e) is improper and should be withdrawn. As also discussed above in connection with claim 1, neither Tsai '775 nor any of the other cited references teach or suggest modification to include a bias.

Claims 22-30 depend from claim 21, and are therefore believed to be allowable for those reasons set forth above in connection with claim 21.

Independent claim 31 recites a seating unit including a pair of armrests that are movably mounted to a frame for movement between forward and rearward positions. Claim 31 recites that "the armrests are biased into the forward position" (emphasis added).

As discussed above in connection with claims 1 and 21, Tsai '775 does not teach or suggest armrests that are biased into a forward position. Applicants further assert that there would be no reason to modify Tsai '775 to include a heart and pawl device because Tsai '775 already teaches blocks 47 and grooves 32 to retain the armrest in a selected position. There is absolutely no teaching or suggestion in Tsai '775 or the other cited references to eliminate the engagement blocks 47 and engagement grooves 32 of Tsai '775 that retain the armrests in one of a plurality of discreet fore/aft positions and replace these features with a heart and pawl device that only retains the armrest in a single selected position.

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Applicants note that "It is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Weslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965); see also *In re Mercer*, 515 F.2d 1161, 1165-66, 185 USPQ 774,778 (CCPA 1975). Applicants respectfully assert that substantial modifications to Tsai '775 would be required to provide the arrangement of independent claim 31, and neither Tsai '775 nor Bivens '454 teach or suggest such modifications.

Claims 32-35 depend from claim 31, and are therefore believed to be allowable for those reasons set forth above in connection with independent claim 31.

Applicants have made a concerted effort to place the present application in condition for allowance, and a notice to this effect is earnestly solicited. In the event there are any remaining informalities, the courtesy of a telephone call to the undersigned attorney would be appreciated.

Respectfully submitted,

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Date

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